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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,695	02/09/1999	MICHITO WATANABE	2091-0186P-S	6491

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/246,695

Applicant(s)

WATANABE ET AL.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This action is in response to Applicant's amendment and request for reconsideration filed on July 31, 2002. Claims 1-9 and 11-27 are presented for further consideration.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 4-6, 8-9, 11-12, 15-21, and 24-27 are rejected under 35 U.S.C. 102(e) as being unpatentable over Garfinkle (U.S. Patent No. 6,133,985).

In considering claims 1, 4, 6, 8, 11-12, and 20-21 Garfinkle discloses a system comprising:

- Image storing means for storing a plurality of image (*See, col. 6, lines 64-67*);

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- Image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be view on the network (*See, col. 4, lines 7-13 and col. 7, lines 5-10*);
- Mail generating means for generating an electronic mail message with the selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic mail with attached image to activate an address that point the recipient to a file which stores the selected image (*col. 5, lines 25-28 and col. 7, lines 10-16*);
- Destination address specifying means for enabling the service user to specify a destination address of the electronic mail message (*See Fig 5C, destination address specifying means is an inherent feature of the transmittal of electronic mail*); and
- Mail transmitting means for transmitting the electronic mail message to the destination address specified by the destination address specifying means (*See Fig 5C*).

In considering claims 5, 9, 15, and 24 although not explicitly stated, it is well known and inherent for an electronic mail system to comprises a user address setting means for enabling the service user to set their electronic mail address thereof, characterized by that the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message.

In considering claim 17, the claim is substantially the same as claims 1 and 5 therefore the same grounds of rejection are applicable.

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In considering claims 18, Garfinkle discloses a system comprising:

displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user; selecting at least one of the plurality of selectable images at the user's device; displaying the selected at least one image in a manner that distinguishes the at least one image from the rest of the selectable images (*col. 7, lines 5-10*);

reading an image file corresponding to the selected image from a memory; converting the read image file into an attachment document format for the electronic mail message (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*); and transmitting the electronic mail message with attached image to the recipient (*col. 7, lines 11-16*).

In considering claims 19 and 25, displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user; selecting at least one of the plurality of selectable images at the user's device (*col. 7, lines 5-10*);

Displaying at the same time a comment box (*subject box*), a destination input box (*address box*), and images (*attachments*) having been selected as targets of transmission (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*);

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reading an image file corresponding to the selected image from a memory; converting the read image file into an attachment document format for the electronic mail message (*although not specifically stated the aforementioned features are inherent features of adding attachments to e-mail*); and transmitting the electronic mail message with attached image to the recipient (*col. 7, lines 11-16*).

In considering claims 26 and 27, the claim contain similar limitation as those previously rejected in claims 1, 5, and 18 therefore the same grounds of rejection are applicable.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3, 7, 13-14, and 22-23 are rejected under 35 U.S.C. 102(e) as being unpatentable over Garfinkle (U.S. Patent No. 6,133,985) in view of Parulski (EPO 0860980 A2).

In considering claims 2, 7, 13, and 22 While Garfinkle discloses allowing the photographer to perform specific task using the digital images such as e-mail, and creating photographic merchandise including t-shirts, mugs, mouse pads, puzzles, ties, buttons, etc. Garfinkle does not explicitly disclose comment-inputting means for enabling the service user to

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input a comment on the image selected by the image selecting means as claimed. However, inputting text on digital images is well known as evidenced by Parulski.

In similar art, Parulski teaches that such descriptive text as, "Hi, I'm having a relaxing vacation, John Smith" can be added to the digital image prior to e-mailing or alburning in order to provide the recipient of the emailed image with information describing the image (See. Fig. 2, which illustrates creatives such as backgrounds and text messages being added to an image and also Pg. 3, lines 25-27, which teaches that through a software application one or more creative backgrounds and text messages can be selected by the user). The means of inputting text onto the image allows to photographer to be creative with processed images. One skilled in the art would have clearly recognized that modifying the image processing and distributing system as disclosed by Garfinkle with the comment-inputting means as disclosed Parulski would have expanded the creative capabilities of the photographer thus advantageously yielding more descriptive and creative images. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Garfinkle.

In considering claim 3, 14, and 23 although the system taught by Garfinkle discloses substantial features of the claimed invention, it fails to disclose an attachment mode selecting means for enabling the service user to select an attachment mode by presenting a plurality of attachment modes as formats for attaching the image, wherein the mail generating means attaches the image according to the attachment mode selected by the attachment mode selecting means. Nonetheless, means for enabling the service user to select an attachment mode as a format for attaching images to email is well known as evidenced by Parulski.

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In similar art, Parulski discloses an image detail section that describes different file types (e.g. FlashPix, JPEG, TIFF) for attaching images (See Fig. 4, and Pg. 4, lines 56-57). Thus, given the teaching of Parulski, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including the attachment mode selecting means taught by Parulski in the digital image processing system taught by Garfinkle so that the user could choose the appropriate format to send the image in order to accommodate the recipients system capabilities. Therefore, the claimed limitation would have been an obvious modification to the system taught by Garfinkle.

### ***Response to Arguments***

Applicant contends that the Examiner has failed to point out in the Official Action the deficiencies of the teachings of the portions of the Garfinkle et al., and has also failed to provide the portion of the Parulski reference relied upon in establishing a 103 rejection. Examiner respectfully disagrees. The Examiner has provided the necessary elements to establish a 103 rejection, which include cited sections of the prior art references, explanations of their combinations and the motivation for doing so. Examiner maintains that the cited references read on the claimed limitations, and therefore maintains the outstanding rejections.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238, for After Final communications

(703) 746-7239, for Official communications

(703) 746-7240, for Non-Official/Drafts.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


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Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
October 21, 2002



Dung C. Dinh  
Primary Examiner